Claim 9, a method claim (Opinion, p. 9), recites as its last step, "*uniformly* moving the film in a circumferential direction past said point"; thus uniformity of movement was an element of the claim. The disclaimer (Opinion, p. 9) merely limits the claim by restricting this broad element, as allowed by the Patent Office, to one wherein *this uniformity* of movement of the film is effected by "the control of the inertia of a rotating weighty mass". What the disclaimer did was to limit the claim "to a specific type of the general class", to wit, uniformity of movement *by flywheel control*—the only type of control mentioned in the patent for the purpose.

Precisely the same is true of claim 13, an apparatus claim (Opinion, p. 9). It recites as an element, "*means* for imparting to the film a rapid and *uniform motion* longitudinally of the film past said cell" and the disclaimer limits this element of the claim "to a specific type of the general class", to wit, to the use of the flywheel for imparting said uniform motion—the flywheel being the only means mentioned in the patent for that purpose.

Yet this Court (Opinion, p. 10), after stating that the statute affords "a wide scope for relinquishment" when the effect is to restrict the claim, condemns this disclaimer solely because of the alleged new element, as being a disclaimer

> "whereby the patent originally for one combination is transferred into a *new and different one* for the *new combination.*"

We believe the Court failed to appreciate the relation pointed out between the original claims 9 and 13 and what was added to restrict them. Both claims originally required uniformity of movement and the teaching of the patent was to use a flywheel positioned as in the structures disclosed. The disclaimer limited the claim to flywheel control. *No new element was added.* The general class

of uniformity was limited to one of its species—uniformity accomplished by specific means, instead of by any means.

The cases cited with approval in the Court's opinion authorize the addition of a new element if its effect is to limit a general class covered by the claim to one of its species, and *the disclaimers in some of these cases cited with approval do add a new element to the claims.*

In *United Chromium, Inc.*, v. *International Silver Co.* (60 F. [2d] 913), approved and cited by this Court as one of the cases where the disclaimer limited the claim to "a specific type of the general class to which it was applied", Judge Learned Hand writing for the Court, stated, that the disclaimer added an element to the claim,

> "he filed a disclaimer by which he narrowed all the claims in suit but 3, 16 and 18, *adding as an element* that the radical must be", etc. (p. 914),

and

> • • • • • •
>
> "It has never been held that the office of a disclaimer is more than to narrow the claim by the *added element*" (p. 915).

Claim 1 of the patent there in suit, for example, claimed:

> "A method of electrodepositing chromium from solutions of chromic acid, comprising reducing chromic acid at the cathode in the presence of a catalyst and of a protecting hydrogen film" (Official Gazette, Vol. 345, p. 628).

In the opinion of the District Court (53 F. [2d] 390, 395), it is said of the disclaimer:

> "Plaintiff filed a disclaimer, disclaiming from claims 1, 2, 4, 11 and 12, any method of electrodepositing chromium in which *regulating a radical component of the bath* (other than or in addition to the chromic

acid radical) is not practiced in maintaining the efficiency thereof;"

* * * * * *

"By the disclaimer, the claims are all limited to *the step of* maintaining the efficiency of the bath by *regulating the radical component of the bath* (other than or in addition to the chromic acid radical)."

Thus the disclaimer in the Chromium case did add to the claims as a new step or element—regulating the radical component of the bath, for it was a feature or step not even mentioned broadly in claim 1, for example.

Again, in *Hurlbut* v. *Schillinger* (130 U. S. 456, discussed, *infra,* p. 8), cited in the present opinion of this Court with approval, the effect of the disclaimer was also to add a new element to the claim.

In the *Minerals Separation* case (250 U. S. 336) referred to by this Court with approval, as illustrating another valid disclaimer which limited the claim "to a specific type of the general class to which it was applied", the facts were as follows: The disclaimer was directed to three claims previously held invalid (pp. 353-354). These were claims 9, 10 and 11 (p. 339). Claim 9 was:

"The process of concentrating powdered ores which consists in separating the mineral from the gangue by coating the mineral with oil in water containing *a small quantity of oil,* agitating the mixture to form a froth, and separating the froth" (Minerals Separation v. Miami Copper Co., 237 Fed. 609, 612).

The disclaimer disclaimed from said claims and others

"any process of concentrating powdered ores, excepting where the results obtained are the results obtained by the use of oil in a quantity amounting to *a fraction of 1 per cent. on the ore*" (Butte & Superior Mining Co. v. Minerals Separation, 250 Fed. 241, 249-50).

It is apparent that the original claim covered all processes of the general class in which "a small quantity of oil" was used, just as in the case at bar, claim 9 covered all methods of the general class in which the film was moved uniformly. The disclaimer limited the claim from one for "a small quantity of oil" to one for a quantity amounting to "a fraction of 1 per cent. on the ore", i. e., to "a specific type of the general class" just as the disclaimer at bar limited claims 9 and 13 to a specific type of the general class of uniform movement.

In the *Seiberling* v. *Thropp* case, supra, the third case referred to by this Court as illustrating an approved type of disclaimer the effect of which was to limit the claim to "a specific type of the general class to which it was applied", the facts were these: One of the claims to which the disclaimer was directed, for example, was:

> "22. An open tire-shoe making machine comprising the combination of a sheet-fabric supply, a power-driven ring core, a radially moving support laterally power-pressed toward the core, and a spinning roll mounted on the support for passing radially along the sides of the tire-shoe to shape the sheeted fabric on the core, substantially as described" (284 Fed. 757).

The claim thus called for a combination of the following elements broadly: (1) a sheet-fabric supply; (2) a power-driven ring core; (3) a radially moving support laterally power-pressed toward the core; and (4) a spinning roll on the support for passing radially along the sides of the shoe to shape the sheeted fabric on the core. The disclaimer to said claim was as follows:

> "I hereby disclaim any combination of the recited elements *except when* constructed and co-ordinated for shaping and applying a previously unshaped sheet fabric strip to that part of the recited ring core beyond the tread portion, *and unless* the power drive for

the ring core functions by a sufficiently high speed of rotation and consequent centrifugal force to throw the unapplied fabric portion out from the side of the ring core, while the recited spinning roll in its radial movement, and while pressed toward the ring core, functions by a gradual action upon such centrifugally thrown-out fabric to shape it to the side of the rotating ring core while bringing it into adhesive contact therewith'' (284 Fed. 757; italics original).

It thus appears that the sheet fabric supply and the cooperation of the ring core were qualified by the application of the sheet fabric to that part of the ring core beyond the tread portion; that the power-driven ring core was limited to one driven at a sufficiently high speed to produce a desired centrifugal force to effect a certain movement of the fabric, and that the spinning roll was limited to one functioning by a gradual action in its radial movement while pressed toward the ring core. In form and in effect the disclaimer goes far beyond the disclaimer to claims 9 and 13 in suit.

This Court also cites with approval (Opinion, p. 10) its former case of *Hurlbut* v. *Schillinger*, 130 U. S. 456. This was a case cited by respondents and by the trial Court (II, p. 1087) as illustrating a disclaimer approved by this Court wherein *a new element was added;* and a careful study of the case will show that the disclaimer there did unquestionably add a new element to the claim. *Yet this Court, while approving its former ruling in the Hurlbut case, condemns the disclaimer here as distinguishing from that one and the other cases above reviewed, solely on the ground that although the disclaimer here narrowed the claims, it ''operated to add the flywheel as a new element''.*

In the Hurlbut case, there was an original patent and a reissue thereof. Both are set forth in parallel columns at pages 459-63 of the opinion. The disclaimer was made to the reissue patent. The patent related to pavements consisting of separable blocks.

The specification of the original patent stated that the invention

> "consists in *combining,* with the joints of concrete pavements, *strips of tar-paper or equivalent material* arranged between the several blocks in such a manner as to produce a suitable *tight joint* and yet allow the blocks to be raised separately without affecting or injuring the blocks adjacent thereto."

This and the remainder of the specification show clearly the use of tar paper or its equivalent placed between the blocks as a *permanent part* of the pavement.

The sole claim in the original patent was:

> "The arrangement of tar paper or its equivalent between adjoining blocks of concrete, substantially as and for the purpose described."

The claim was thus clearly one for a pavement having as a part thereof, tar paper or its equivalent arranged between the adjoining blocks to prevent them from sticking together so that they could be separately removed.

When the patent was being reissued the patentee broadened it by insertions pointing out how the separation of the blocks might be obtained without the use of the tar paper and without leaving any permanent partition or separator such as tar paper between the joints; it being stated:

> "the tar paper may be omitted and the blocks formed without interposing anything between their joints, as previously described", etc.

In the reissue two claims were obtained, claim 2 being precisely like the claim of the original patent with the exception of a change in the last word, which was of no consequence. The new claim was as follows:

> "1. A concrete pavement laid in detached blocks or sections, substantially in the manner shown and described."

As appears from the statements of this Court, the reissue thus contained a claim (claim 2) to a pavement having the *permanent* interposition of tar paper or its equivalent, and claim 1, which was not limited to "interposing anything in the joints" in the process of formation, whether the interposition was *a permanent or a temporary* one.

The disclaimer disclaimed the enlarging language above referred to which was placed in the reissue, and concluded as follows:

> "Your petitioner hereby disclaims the forming of blocks from plastic material without interposing anything between their joints *while in the process of formation*" (p. 463).

The disclaimer was clearly directed to claim 1 and had no bearing on claim 2, which was already limited to the permanent tar paper insertion. It thus added *as a new element* to claim 1, the interposing of something between the joints while in the process of formation. As shown by the further langauge of the opinion, the disclaimer thus left the patent with claim 1 covering broadly interposing something between the joints *either temporarily* in the process of formation or *permanently,* and with claim 2 covering a permanent interposition of tar paper or its equivalent.

Finally, on the disclaimer question this Court states in its present opinion (Opinion, p. 11) that if the disclaimer here were upheld, respondents would in effect secure a new patent

> "without subjecting the new claims to revision or restriction by the customary Patent Office procedure required in the case of an original or reissued patent."

The Court then cites certain cases such as *Hailes* v. *Albany Stove Co.* (123 U. S. 582, 589) in support of this statement; but we respectfully submit that in the case at bar

no harm has been done and none can result from the fact that the Patent Office has not reviewed claims 9 and 13 with the disclaimer written into them. In the present case the Patent Office had already allowed claims on the flywheel control and had also allowed claims 9 and 13 without specifying flywheel control but containing broadly the feature of uniform movement. It necessarily follows that as a matter of course it would have allowed claims 9 and 13 if limited to flywheel control. If "A" is patentable and "B" is patentable, it necessarily follows that "A" plus "B" is patentable. In the Albany Stove case, for example, the added matter had not been held to be a patentable feature as in the case at bar, and, what is more important, it was held to be for a feature not even shown or described in the patent, and having no basis or foundation therein. As this Court said of it, it

> "has nothing in the specification to stand upon, nothing to explain it, nothing to furnish a reason for it."

Its addition was in fact contrary to the teaching of the patent.

This Court in the present opinion as we read it, has broadly condemned the disclaimer here because it added a new element, regardless of what it was and regardless of whether the subject matter was disclosed as part of the original invention. We believe that in this respect the Court has erred.

II. The Law As to Disclaimers Is Confused by the Opinion As It Now Stands.

If we are correct in our analysis of the disclaimer cases approved by this Court in its opinion, as we firmly believe we are, it will be quite impossible for the lower courts to determine whether a disclaimer which adds "a new element to a combination previously claimed" is valid or invalid.

The words of the opinion, "whereby the patent originally granted for one combination is transferred into a new and different one for the new combination" do not remove the confusion or declare any principle upon which the cases may be reconciled, because the addition of *any* new element to *any* combination *always* has this effect. Furthermore the Court approves the validity of disclaimers which limit the claim to a specific type of the general class to which it was applied, but holds invalid the disclaimer in suit which has only that effect when applied to claims 9 and 13. Accordingly we believe we are right in respectfully saying that the decision in this case leaves the law relating to disclaimers in hopeless confusion, and that accordingly there should be a reargument.

The addition of new *matter* by disclaimer should be condemned whether it be in the form of a "new element" or in the form of a statement qualifying an existing element, but new matter is quite different from a "new element". New matter exists when the feature was not disclosed in the original patent as a part of the invention, and when new matter is added by disclaimer it always has the effect pointed out in the present opinion and in some of the decisions cited by this Court condemning disclaimers. A new element may or may not be new matter, and new matter may or may not be in the form of a new element to the claim.

In connection with the disclaimer discussion this Court stated (p. 9):

> "The court below made no reference to the contention of petitioner, urged here and below, that the patent was rendered invalid by the disclaimer";

but the Court below did expressly state:

> "*All the other defenses have been considered,* but we think that they are not substantial" (R., p. 1172).

III. The Court Misapprehended the Facts Affecting Patentability of the Claims Over the Art.

We feel that this Court has been unduly severe in its treatment of the patentees who were unquestionably the first to give sound on film pictures to the world; and in connection with its discussion of patentability of the so-called flywheel claims*, this Court made the following statements of fact tending to negative invention and which may have affected its conclusion (Opinion, p. 9):

> (1) "There was no public demand for sound motion pictures before 1926, when the disc system of the Western Electric Company was first publicly used in conjunction with moving pictures."
>
> (2) "Before *change to the photographic film* system could be accomplished, it was necessary to await the development of numerous electrical devices not embraced in the present claims."

(Meaning a change from the Western Electric disc sound system to the photographic film system like that of the patent in suit.)

> (3) "Among them [these electrical devices] were adequate amplifiers, loud speakers and microphones. Progress in the perfection of these appliances was *achieved rapidly, after the public acceptance of the sound picture in 1926,* through the efforts of many independent workers in the field."

These statements appear to be the answer to some of respondents' contentions on patentability, i. e., that there had been a demand for sound pictures as evi-

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*Only the so-called flywheel claims were considered as to patentability.

denced by the many scientists and corporations who were endeavoring to accomplish sound on film sound pictures; that although Western Electric had struggled for years before 1926 to accomplish sound pictures, trying for it both with sound on film and with sound on disc, they gave up sound on film and had to resort to sound on disc which they first brought out commercially in August, 1926; that exactly the same requirements with respect to amplifiers, loud speakers and microphones were necessary for the disc system as for the photographic film system; and that this being the admitted fact, petitioners' contention that these electrical devices were the things that held back sound on film, could not be true; and that these things were available, and yet Western Electric had been forced to the disc system.

This Court has apparently accepted bodily petitioners' contentions without regard to the record. Taking up the above items (1) to (3) in the reverse order, we are unable to find anything in this record to support the Court's statement (3) above, that the progress in the electrical devices —amplifiers, loud speakers and microphones, was achieved rapidly *after 1926.* Indeed, if the Court is willing to accept the testimony of petitioners' own expert, Waterman, his testimony is as follows: after testifying about amplifiers, loud speakers and microphones, at II. page 641: Waterman testified as to the development of these devices:

> "It has been the product of many workers over a long period, probably running from about 1912, when amplifiers were first seriously considered, *down to 1926,* when we first had motion [sound] pictures that had the capacities to stay" (II, p. 642).

And furthermore, we can find no testimony to show that these electrical devices were not of sufficiently advanced development to justify commercial sound pictures long prior to 1926. *Indeed, the record clearly and indisputably shows that the patentees had them in Germany as early*

as 1922 (I, pp. 68, 120). Under the Court's reasoning in this case, this date—1926—is critical because the Court, *under an entire misapprehension,* is reasoning that the Western Electric gave up its efforts in sound on film for discs prior to 1926 because it needed these devices for the film system but not for the discs, and that when after 1926 the necessary improvements in these devices were made, it was obvious to provide the invention here. But this was not the situation, as will next be shown.

As to item (2), that before change to the photographic film system could be accomplished it was necessary to await the development of these electrical devices,—again we can find no justification in the record for this statement. It is apparently based on the erroneous belief that the disc system did not require the same degree of development of these electrical devices as does the sound on film system. The Court was apparently laboring under the misapprehension that for disc sound pictures, all one had to do was to put an old mechanical gramophone alongside of the picture machine and gear them together, and it no doubt was led into this by statements in petitioners' brief.

But if this Court is willing to accept the testimony of petitioners' own expert, Waterman, on this point, it, as well as other testimony in the case, clearly shows that *the same character of amplification is necessary to and is used in both the disc and the photographic film systems.* In the disc system the old mechanical stylus with vibrating diaphragm is not used, but a very delicate instrument known as the electric pickup, which requires amplification of the electric currents produced by the vibration of the needle.

Waterman, testifying with respect to Petitioners' Exhibit 69,—a chart (IV, p. 723) showing the R. C. A. system and machines equipped to use either the disc or the film system—states with respect to this equipment:

> "There is also a large amplifier, and here again the amplification is very large. When the sound is picked

> up, *either from the disc or from the film,* the currents which are actually furnished as the result of the sound record, are very, very feeble. They require very great amplification. This amplification system is depicted in Exhibit 69, and it produces an amplification of ten thousand millions in energy" (II, p. 640).

Said chart also shows the same wire running from the disc system and the film system to the sound electrical devices.

As to item (1) that there was no public demand for sound pictures before 1926 when the disc system of the Western Electric was first publicly shown, we can find no suggestion on the record that there was any greater public demand resulting from this showing (in a single theatre of Warner Bros.) in the summer of 1926 than existed before then. Furthermore, we submit that the record does show the existence of public demand for sound pictures long prior to this date. It shows that *there was a real demand by the public as far back as 1913* when the old Edison disc sound picture machines—about 500 were made—were taken into all of the principal vaudeville houses of the United States and Canada (2,000 shows having been given at an exposition), and also exhibited abroad, and foreign rights sold for the purpose; and this notwithstanding the crude quality of the system; see testimony of petitioners' own witness (I, pp. 342, 351, 356, 363, 378; IV, p. 625).

The record also shows that the General Electric Co. was striving to obtain sound pictures prior to 1920 and thereafter (I, pp. 599-630); that Lee DeForest was working in Germany and this country on this problem prior and subsequent to 1922 (I, p. 68[illegible]; that Mr. Case prior to 1925 was working on this problem (I, p. 223); that Mr. William Fox, then in charge of one of the largest motion picture organizations in the world, interested himself as early as 1925 about acquiring a suitable sound on film sound picture system, and that prior to said Western Electric exhibition he had the Case system in New York and sent abroad for an

examination of the Tri-Ergon system; also Western Electric had been struggling since 1913 up to 1923 to produce sound pictures (see Record in No. 254, I, pp. 312-14). The 1913 date is significant. They recognized the public demand proven by Edison in that year to have existed.

Certainly these people were not interesting themselves and spending their money for the fun of it. *There was a great public demand ever since 1913.* And yet this Court states that there was no public demand until 1926, and that "when the need arose for a mechanism suitable to move film records with such speed constancy as to produce sound successfully, it was forthcoming" (Opinion, p. 9). It was forthcoming, but from these patentees, and as early as 1921, who were the first to give sound on film sound pictures to the world, and their work has now been appropriated by the great corporations of this country, and with impunity under this Court's treatment of what, we respectfully submit, was a pioneer invention.

A rehearing should be granted.

Respectfully submitted,

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